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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,180	09/29/2000	David Suda	192400US55X	2909

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/26/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,180

Applicant(s)

SUDA ET AL.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14, 19, 20, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-14, 19, 20, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Withdrawn Rejections***

1. The 35 U.S.C. 112 rejection of claim 11 of record in Paper#10, Page 2, Paragraph 1 have been withdrawn due to Applicant's amendment in Paper #11.

### ***Rejections Repeated***

2. The 35 U.S.C. 102 rejection of claims 11-13 as anticipated by Knapp et al. is repeated for reason previously of record in Paper#10, Page 2, Paragraph #2.

As to newly claim 11, Knapp et al. discloses a backing sheet comprising a first side having an adherent material thereon (figure 4 number 30 and 34), the first side with the adherent material (figure 4 number 34) having a fiberglass sheet receiving portion (figure 4 number 52,30), a second side, a stapling tab extending along an edge of the backing sheet (figure 4 number 42), the stapling tab having a first portion of the second side positioned against a second portion of the second side, and a tacky substance bonding the first portion of the second side to the second portion of the second side (figure 4 number 42).

3. The 35 U.S.C. 102 rejection of claims 19-20 as anticipated by Jorgenson et al. is repeated for reasons previously of record in Paper#10, Page 4, Paragraph #3.
4. The 35 U.S.C. 103 rejection over Knapp et al. in view of Bose et al. is repeated for reasons previously of record in paper#10, Page 5, Paragraph #4.

***New Rejections***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 32-33 are rejected under 35 U.S.C. 102(e) as being unpatentable by Jorgenson et al.

Jorgenson et al. discloses a stapling tab comprises a first fold extending along an edge of the backing sheet, the first fold extending along an edge of the backing sheet (figure 10 number 220), the first fold having a first portion of the first side bonded to a second portion of the first side (figure 10 number 220) by the adherent material (figure 10 number 202). Jorgenson et al. discloses that the portion of the adherent material extending through at least one hole (col. 7 line 11-12) bonds the first portion of the second side to the second portion of the second side (figure 10 number 220').

***Response to Arguments***

6. Applicant's arguments filed in Paper#11 have been fully considered but they are not persuasive.

In response to applicant's argument that Knapp et al. does not disclose a tacky substance bonding the first portion of the second side to the second portion of the second side, Knapp et al. does disclose an adherent material (figure 4 number 34) bonding the first portion of the second side to the second portion of the second side (figure 4 number 42,34). The "second side" in Knapp et al. is referred to the right side of the backing sheet and not the backside of the backing sheet. The second side wherein the number 42 is assigned, the adherent material 34 bonds to the first portion of the second side to the second portion of the second side.

In response to applicant's argument that Jorgenson et al. does not disclose that a portion of the adherent material extends through at least one hole and contacts the second side of the backing sheet, Jorgenson does disclose that a portion of the adherent material (col. 7 lines 11-12) extends through at least one hole and contacts the second side of the backing sheet (figure 10 number 208).

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*Jane Rhee*  
12/24/02

*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

12/24/02